



SERIAL NO. 10/036,058

PATENT APPLICATION

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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Applicant:	MULLIGAN	Examiner:	Chang, J.
Serial No.:	10/036,058	Group Art Unit:	2154
Filing Date:	October 26, 2001	Docket No.:	NOKM.016PA
Title:	MOBILE CLIENT PROVISIONING WEB SERVICE		

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 24, 2006.

By: \_\_\_\_\_

Steven R. Funk

**NOTICE OF APPEAL UNDER 37 C.F.R. § 41.31**

**AND**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant submits herewith a Notice of Appeal and a Pre-Appeal Brief Request for Review. No amendments are being filed with this communication.

Enclosed with this request, Applicant is submitting herewith the following:

- ☒ Notice of Appeal
- ☒ Pre-Appeal Brief Request for Review (PTO/SB/33)
- ☒ Statement regarding Pre-Appeal Brief Request for Review ( 3 pages)
- ☒ Petition for Extension of Time
- ☒ 1 Return Postcard

Authorization is given to charge/credit Deposit Account No. 50-3581 (NOKM.016PA) for any deficiencies/overpayments associated with this filing.

**HOLLINGSWORTH & FUNK, LLC**  
Attorneys at Law  
8009 34<sup>th</sup> Avenue South, Suite 125  
Minneapolis, MN 55425  
952.854.2700 (tel.)

Respectfully submitted,

By: \_\_\_\_\_

Steven R. Funk  
Reg. No.: 37,830



Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

NOKM.016PA

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on

February 24, 2006

Signature

Typed or printed name

Steven R. Funk

Application Number

10/036,058

Filed

10/26/2001

First Named Inventor

MULLIGAN

Art Unit

2154

Examiner

Chang, J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record.

Registration number 37,830



attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Steven R. Funk

Typed or printed name

952-854-2700 ext. 11

Telephone number

February 24, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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By:

  
Steven R. Funk

**APPELLANT'S STATEMENT IN SUPPORT OF  
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This statement is presented by Appellant in compliance with the USPTO OG Notice of 12 July 2005 on New Pre-Appeal Brief Conference Pilot Program. Appellant is requesting a pre-appeal brief conference on the belief that the rejections of record are clearly not proper and are without basis. Appellant's request is based upon a clear legal or factual deficiency in the rejections, rather than an interpretation of the claims or the prior art teachings. As such, Appellant believes this request for pre-appeal brief review is appropriate.

Claims 1-3, 8-31, 33-35, 38, and 39 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2003/0013434 to Rosenberg et al. (hereinafter *Rosenberg*). Claims 4-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Rosenberg* in view of Scott Seely "Web Service description and Discovery Using UDDI, Part II", Microsoft Corporation (hereinafter *Seely*). Claim 32 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Rosenberg* and *Seely* further in view of U.S. Publication No. 2003/0207685 to Rankin (hereinafter *Rankin*). Claim 37 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Rosenberg* in view of *Rankin*.

As noted in the USPTO OG Notice of 12 July 2005, it is encouraged that Appellants refer to arguments already of record rather than repeating them in the request. Thus, any reference in the present request to “**OAR 5-31-05**” refers to the Office Action response dated May 31, 2005, which was filed in response to the Office Action dated December 17, 2004.

While the Appellants have multiple issues for *appeal*, the primary purpose for submitting this particular *request for review* concerns what appears to be an omission of an essential element needed for a *prima facie* rejection. Each rejection in the final Office Action (dated August 24, 2005) involves the *Rosenberg* reference, and relies on the *Rosenberg* reference as teaching all or a substantial portion of each of the rejected claims, whether rejected under 35 U.S.C. §102(e) on *Rosenberg* alone or under 35 U.S.C. §103 where *Rosenberg* is the primary reference.

The Applicant made multiple arguments concerning the *Rosenberg* reference, and the Examiner’s response to Applicant’s remarks addressed less than all of those arguments (see Office Action dated 8/24/05, paragraphs 26-28). However, an argument has twice been made, and amendments to the claims have been made, regarding a provisioning Web service **implemented using “Web Services.”** The Appellant has on prior occasions indicated to the Examiner that “Web Services” is a technological term of art, known to those skilled in the art, and that the phrase “Web Services” has been adequately defined in the Appellant’s Specification.

The Appellant now refers the Review Panel to one of the Appellant’s prior Office Action responses (OAR 5-31-05), particularly on page 3, lines 6-19, for one of the arguments presented, and an identification of a relevant portion of the Appellant’s Specification.

It is respectfully submitted that there is an omission of an essential element needed for a *prima facie* rejection. *Rosenberg* does not involve or describe provisioning using “Web Services” as the term is used in the pending application. *Rosenberg* is relied upon in both the §102(e) and §103 rejections as teaching a provisioning Web service ***implemented using Web Services***. Because *Rosenberg* does not involve or otherwise address “Web Services,” the Appellant believes this limitation of the claims is improperly being overlooked, and consequently there is an omission of an essential element needed for a *prima facie* rejection.

It is the position of the Appellant that *Rosenberg* cannot anticipate Claims 1-3, 8-31, 33-35, 38, and 39 because *Rosenberg* does not involve or otherwise address this issue. It is also the

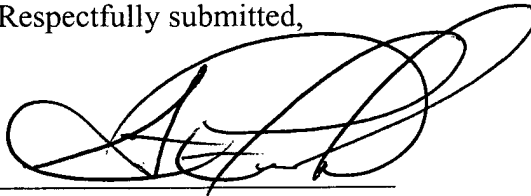
position of the the Appellant that the Examiner's reliance on *Rosenberg* in the §103 rejections as teaching the provisioning Web service implemented using Web Services is also inappropriate, as *Rosenberg* does not address or otherwise involve "Web Services."

Appellant believes that this statement, when viewed together with the prosecution history, sets forth clear grounds for a finding that at least this rejection is improper proper and without basis.

The undersigned is of record and with authority to prosecute the appeal on behalf of the Assignee.

**HOLLINGSWORTH & FUNK, LLC**  
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8009 34<sup>th</sup> Avenue South, Suite 125  
Minneapolis, MN 55425  
952.854.2700 (tel.)

Respectfully submitted,

By:   
Name: Steven R. Funk  
Reg. No.: 37,830